

ESTTA Tracking number: **ESTTA585284**Filing date: **02/03/2014**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91210850
Party	Defendant City of Doral
Correspondence Address	DONALD S SHOWALTER GRAYROBINSON PA 401 EAST LAS OLAS BOULEVARD FORT LAUDERDALE, FL 33301 UNITED STATES don.showalter@gray-robinson.com
Submission	Answer and Counterclaim
Filer's Name	Donald S. Showalter
Filer's e-mail	don.showalter@gray-robinson.com
Signature	/Donald S. Showalter/
Date	02/03/2014
Attachments	Answer.pdf(411104 bytes)

Registration Subject to the filing

Registration No	2700353	Registration date	03/25/2003
Registrant	DESIGN TRADEMARK HOLDINGS, LLC 3841 N.E. 2ND AVENUE MIAMI, FL 33137 GERMANY		
Grounds for filing	The registered mark has become the generic name for the goods.		
	The registered mark has been abandoned.		

Goods/Services Subject to the filing

<p>Class 035. First Use: 1995/01/01 First Use In Commerce: 1995/01/01 All goods and services in the class are requested, namely: Promoting the goods and services of others by preparing and placing listings, namely, print and electronic listings, and advertisements in the media, namely, magazines, newspapers, and other print media, radio, television, recorded copies and in a global computer network, and inflyers, books, posters and billboards, in an on-line directory and catalog accessed through a global computer network, and in hard copy, namely, newspapers, magazines, television, radio, and recordedcopies, flyers, books, posters, and billboards, in the fields of management, rental, and sale of commercial and residential property, promoting neighborhood activities and awareness, landscape design, architecture, personal and home fashions, art, flowers, florists, entertainment, clothing, restaurants, home furnishings and accessories, and shopping</p>
<p>Class 042. First Use: 2001/11/01 First Use In Commerce: 2001/11/01 All goods and services in the class are requested, namely: Computer services, namely providing an on-line magazine in the fields of lifestyle and neighborhood activities, home and personal fashion, home furnishings andaccessories, art, clothing, landscape design, architecture, flowers, florists, entertainment, restaurants, real estate,and shopping</p>

Design Trademark Holdings, LLC , a)	Opposition No. 91210850
Delaware limited liability company,)	
)	Serial No. 85/676794
Opposer,)	
)	Mark: DORAL DESIGN DISTRICT
v.)	& Design
)	
City of Doral , a Florida municipal)	
Corporation,)	
)	
Applicant.)	
)	

Applicant, City of Doral, a municipal corporation existing under the laws of the State of Florida, located and having its government offices at 8300 NW 53rd Street, Doral, Florida 33166, by its undersigned attorney, hereby submits its Answer to the Notice of Opposition filed by Opposer, Design Trademark Holdings, LLC against Serial No. 85/676,794 for registration of the mark “D D D DORAL DESIGN DISTRICT and Design”, and its counterclaims against Opposer, as follows.

1. Answering paragraph 1 of the Notice of Opposition, Applicant admits the allegations set forth therein.
2. Answering paragraph 2 of the Notice of Opposition, Applicant admits the allegations set forth therein.
3. Answering paragraph 3 of the Notice of Opposition, Applicant admits the allegations set forth therein.

4. Answering paragraph 4 of the Notice of Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth therein, and therefore denies same.

5. Answering paragraph 5 of the Notice of Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations that Opposer is the owner of United States Trademark Registration No. 2,700,353 and that said registration is “Opposer’s Registration”, and therefore denies those allegations. Any and all other allegations set forth in paragraph 5 of the Notice of Opposition are admitted by Applicant.

6. Answering paragraph 6 of the Notice of Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth therein, and therefore denies same.

7. Answering paragraph 7 of the Notice of Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth therein, and therefore denies same.

8. Answering paragraph 8 of the Notice of Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth therein, and therefore denies same.

9. Answering paragraph 9 of the Notice of Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth therein, and therefore denies same.

10. Answering paragraph 10 of the Notice of Opposition, Applicant denies the allegations set forth therein.

11. Answering paragraph 11 of the Notice of Opposition, Applicant denies the allegations set forth therein.

12. Answering paragraph 12 of the Notice of Opposition, Applicant denies the allegations set forth therein.

13. Answering paragraph 13 of the Notice of Opposition, Applicant denies the allegations set forth therein.

DENIAL OF ALL ALLEGATIONS NOT ADMITTED

14. Applicant denies each and every allegation in the Notice of Opposition not expressly and specifically admitted in any of paragraphs 1 through 13 above.

DEFENSES AND AFFIRMATIVE DEFENSES

15. No likelihood of confusion as to the source, origin, sponsorship, approval or affiliation of any of the services listed in Applicant's Application Serial No. 85/676,794 ("Applicant's Application") on one hand, and any of the services listed in U.S. Trademark Registration No. 2,700,353 on the other hand, would be engendered by registration of the mark "D D D DORAL DESIGN DISTRICT and Design" by Applicant in connection with any of the services goods listed in Applicant's Application.

16. On information and belief, U.S. Trademark Registration No. 2,700,353 is invalid, in whole or in part, by reason of abandonment of the alleged mark "MIAMI DESIGN DISTRICT and Design" in connection with at least one or more of the services listed in said registration.

17. On information and belief, the alleged mark "MIAMI DESIGN DISTRICT and Design" is generic for at least one or more the services listed in U.S. Trademark Registration No. 2,700,353 and said registration is therefore invalid as to at least said one or more the services as to which the alleged mark "MIAMI DESIGN DISTRICT and Design" is generic.

**First Counterclaim for Cancellation or Partial
Cancellation of U.S. Trademark Registration No. 2,700,353**

18. Applicant incorporates by reference as if fully set forth herein in their entirety, and re-avers, all of the averments made in paragraphs 1 through 16 above and requests cancellation of U.S. Trademark Registration No. 2,700,353 in its entirety, or in part, as to any and all services listed therein as to which the alleged mark "MIAMI DESIGN DISTRICT and Design" has been abandoned.

**Second Counterclaim for Cancellation or Partial
Cancellation of U.S. Trademark Registration No. 2,700,353**

19. Applicant incorporates by reference as if fully set forth herein in their entirety, and re-avers, all of the averments made in paragraphs 1 through 17 above and requests cancellation of U.S. Trademark Registration No. 2,700,353 in its entirety, or in part, as to at least those services listed therein as to which the alleged mark "MIAMI DESIGN DISTRICT and Design" is generic.

WHEREFORE, Applicant requests judgment against the Opposer as follows: (a) that this Opposition be dismissed; (b) that Application Serial No. 85/676,794 be allowed; and (c) that U.S. Trademark Registration No. 2,700,353 be cancelled or cancelled in part.

Date: February 3, 2014

Respectfully submitted,

GrayRobinson, P.A.

By: 

Donald S. Showalter, Esq.

GrayRobinson, P.A.

401 East Las Olas Boulevard, Suite 1000

Fort Lauderdale, FL 33301

Telephone: (954) 761-7473

Counsel for Applicant City of Doral

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of Applicant's foregoing ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIMS has been served on Leslie J. Lott Esq., counsel for Opposer, by mailing said copy on February 3, 2014, via First Class Mail, postage pre-paid, to:

Leslie J. Lott, Esq.
Lott & Fischer PL
355 Alhambra Circle, Suite 1100
PO Drawer 141098
Coral Gables, Florida 33134-1098

By: 

Donald S. Showalter, Esq.
GrayRobinson, P.A.
401 East Las Olas Boulevard, Suite 1000
Fort Lauderdale, FL 33301
Telephone: (954) 761-7473
Attorney for Applicant City of Doral